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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/691,589

10/18/2000

Lirio Quintero

154-12786-US-CIP

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EXAMINER

METZMAIER, DANIEL S

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/691,589

Applicant(s)

QUINTERO, LIRIO

Examiner

Daniel S. Metzmaier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 25-34, 37-46, 49, 50 and 53-195 is/are pending in the application.
- 4a) Of the above claim(s) 37-42 and 53-79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 25-34, 43-46, 49, 50 and 80-195 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

DETAILED ACTION

Claims 1-15, 25-34, 37-46, 49-50, 53-195 are pending. Claims 37-42 and 53-79 have been withdrawn at this time.

Response to Amendment

1. Applicants amendment to the specification has not been entered because said amendment is not proper under 37 CFR 1.121.

Election/Restrictions

2. Claims 37-42 and 53-79 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Invention, Group II, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

Priority

3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994). Since the instant application is a CIP of the parent application, by definition of a CIP, the

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disclosure of the invention is different than that of the parent and therefore the provisional application.

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification of in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number. While the instant application is a CIP of application number 09/426,172, said cross noting should include reference to the provisional application, which said parent application claimed benefit.

Applicants should update the cross-noting section at page 1, line 7, by inserting after "1999" the phrase - - , which claims benefit to provisional application number 60/105,502, filed October 23, 1998 - - .

Claim Objections

4. Claims 110 and 112 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The range of "about 10 microns or less" is broader than the range "from about 3 microns to about 20 microns" since said range includes 0-3 microns. It is suggested applicants employ the range "about 3 microns to about 10 microns".

Claim Rejections - 35 USC § 112

5. To the extent, applicants intend to invoke 36 USC 112, sixth paragraph, in claim 194, applicants should so state and set forth where said means is defined in the specification.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-15, 25-34, 43-46, 49-50, and 80-195 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of the "adapted to initiate acid reactive polymerization of a polymerizable encapsulating material" is unclear since it is unclear what is polymerized.

The scopes of the claims are indefinite since the claims employ open language when defining subgenus or species in an alternative grouping. See for example, claims 82-88, 104, 108, 180-182, employs "said polyoxyethylene alcohols comprise" where claim 1 employs Markush language defining "emulsifiers selected from the group consisting of". Also claims 86-88, 104, 108, 180-182 employ the improper language "selected from the group consisting essentially of". It is unclear what are the metes and bounds of the claimed subject matter sought to be patented. The alternative groupings should use closed language, ie., "selected from the group consisting of".

In the claims, eg, 89-94, 116-117, 131, 138-140, 150-152, 171-173, 184-188, the "ratio" is undefined, eg., wt/vol, weight, volume, or molar. Depending on how said ratio was to be defined, the scope of said ratio would differ.

In claims 31 and 44, "said anionic emulsifiers" defined as poloxyethylene alcohols. It is unclear what applicants intend.

Applicant should review all of the 147 claims under consideration for the issues raised in this rejection, address each issue and/or take appropriate action.

Claim 194 is indefinite since it is unclear what means applicants intend for each of the means plus function recitations of the claim.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-14, 25-29, and 80-99 are rejected under 35 U.S.C. 102(b) as being anticipated by Otrhalek et al, US 4,032,466. Otrhalek et al (example 3 and claims, particularly claim 8) discloses compositions reading on the claims. Said compositions (all parts are by weight – see column 8, lines 59-62) comprise 12 parts alpha-alkyl-omega-hydroxy poly(oxyethylene) with an average of 9 moles of oxyethylene, 4 parts of linear alkyl sulfonic acid, denoted as Calsoft LAS-99, and 30 parts of 37% hydrochloric acid. The nonionic (12) to anionic (4) ratio equates to 75/25, which reads on the claimed ratios. The pH would have been inherent to the 30 parts of the 37% hydrochloric acid. Typical pH of a 0.1N HCl solution is pH = 0.1. 0.1N equates to about a 3.6% hydrochloric acid solution. The concentration of the hydrochloric acid media of Otrhalek et al is an order of magnitude greater and would have been expected to have a pH of 1 or less.

9. Claims 1-9, 25-36, 80-88 and 95-99 are rejected under 35 U.S.C. 102(b) as being anticipated by Lambremont et al, US 5,707,952. Lambremont et al (column 2,

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lines 38 et seq; example 1, table bridging columns 9 and 10; and claims, particularly claim 1) disclose aqueous acidic cleaners, which are in the form of microemulsions containing up to 2% by weight of water-insoluble hydrocarbon. Partentees claimed pH for the compositions may range from about 1 to about 4. Said range reads on the instantly claimed about 1 or less.

10. Claims 1-6 and 25-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Thomas et al, US 5,129,460. See examples, tables and claims.

Response to Arguments

11. Applicant's arguments filed July 18, 2003 have been fully considered but they are not persuasive.

12. Applicant (page 27 of the response) asserts in response to the rejections under 35 USC 112, second paragraph that claims 1-36 and 43-52 are in condition for allowance. The remaining issues need to be addressed as set forth above.

13. Applicants (pages 27 to 29) assert that to establish a rejection under anticipation, each element must be taught or inherent. The claimed compositions are indistinct from those disclosed in the prior art except for applicant's functional language. Since the compositions appear to be the same and the properties of a compound or composition are generally inseparable from said compound or compositions, it logically follows that the compositions would be anticipated by the prior art of record as set forth in the above rejections.

Applicants further assert the use of transitional language "consisting essentially of" distinguishes the prior art to Otrhalek et al since said reference is directed to a

cleaner and includes a flocculating agent. This has not been deemed persuasive since applicants claims further claim the compositions must be adapted to polymerization and encapsulation but do not define the encapsulant or polymerization reaction. Applicant has the burden of showing said language distinguishes the instant claims. See MPEP 2111.03. "For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to 'comprising.' See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355."

14. Applicants make the same arguments for the remaining prior art rejections as addressed above regarding the Otrhalek et al reference. Said arguments have been addressed above.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Metzmaier whose telephone number is (703) 308-0451. The examiner can normally be reached on 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on (703) 308-2340. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read "Daniel S. Metzmaier".

Daniel S. Metzmaier
Primary Examiner
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DSM